

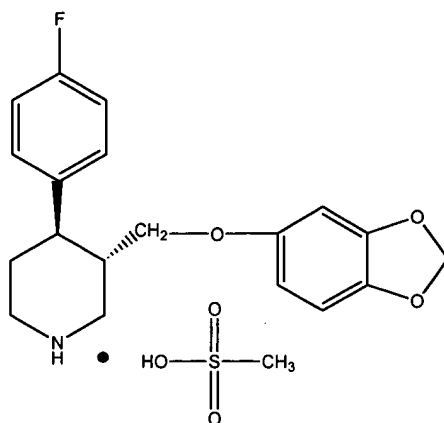
REMARKS

Claims 1-9, 11, 15, 17, 20-22, and 24-29 have been cancelled and replaced with new claims 30-39 in this divisional application. Support for the new claims is believed to be self-evident. However, for the Examiner's convenience, her attention is directed to the Experimental and Example 1 procedures on pages 9-11 of the specification where crystalline paroxetine methane sulfonate is formed. In both procedures, ethyl acetate was used as the solvent from which the crystals were precipitated. Table 1 on page 14 lists several IR peaks for this substance. The pharmaceutical composition claims (33-35) and the methods of treatment claims (36-38) are supported at least by the disclosure at page 6, lines 29-36, of the specification as well as original claims 11 and 13. Claim 39 is supported, *inter alia*, by the description at page 8, line 23, and the surrounding text as well as by original claim 15. Accordingly, no new matter has been introduced into the application by the above-amendment.

The new claims are clearly patentable over the prior art. As discussed with the Examiner during the personal interview of November 21, 2000, "crystalline" paroxetine methane sulfonate is already generically covered by claim 21 of applicants' earlier patent, U.S. 5,874,447 (hereinafter the '447 patent), which issued from the grandparent application (08/872,023 filed June 10, 1997) of the instant CPA.

In particular, claim 21 of the '447 patent reads as follows:

21. A compound of the following formula:



The structure recited in claim 21 corresponds to paroxetine methane sulfonate, but no limitation is present regarding the form of the compound. Thus, claim 21 embraces crystalline, non-crystalline, amorphous, dissolved forms, etc. of paroxetine methane sulfonate.¹ Given that this genus of all forms of paroxetine methane sulfonate is patentable over the prior art, then the instantly claimed “crystalline” form is likewise and necessarily patentable over the prior art.

Although not prior art to the present application, the Examiner’s attention is directed to Craig *et al.* U.S. Patent 6,603,927 (hereinafter the ‘927 patent). As mentioned during the interview, the claims in the ‘927 patent recite paroxetine methane sulfonate “in crystalline form” and further recite eight purportedly characteristic IR peaks. The ‘927 patent was filed

¹ Note also column 7 at lines 27 and 33 of the ‘447 patent wherein two different forms of paroxetine methane sulfonate are disclosed; an oil form and a crystalline form.

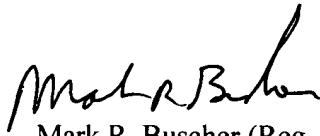
after the '447 patent issued; yet the '927 applicants did not attempt to provoke an interference with claim 21 of the '447 patent. In addition, the PTO did not *sua sponte* declare an interference with claim 21 of the '447 patent.

But this does not, however, end the matter with regard to the '927 patent. As mentioned during the interview, the "crystalline" paroxetine methane sulfonate recited in the claims of the '927 patent is the same crystalline paroxetine methane sulfonate described, and now specifically claimed, in the present application. Accordingly, an interference is required. Pursuant to Rule 607(c), applicants bring to the Examiner's attention, as was also done during the interview, that claims 30-32 presented above are believed to correspond substantially to claims 1 and 3 of Craig et al, U.S. Patent 6,063,927. In addition, it is believed that claim 39 presented above corresponds substantially to claims 2 and 4 of the '927 patent. A complete submission under Rule 607 will follow shortly for the purpose of provoking an interference with the Craig patent.

During the interview, the Examiner questioned whether the subject matter of new claim 39 was patentably distinct from claim 7 of the '447 patent. Specifically, claim 39 is a species of the genus already patented in the grandparent application. While not conceding the propriety of such a position, in order to expedite the handling of the interference, applicants will submit an executed Terminal Disclaimer shortly. Accordingly, any issue of obviousness-type double patenting between instant claim 39 and claim 7 of the '447 patent will be obviated.

Should the Examiner have any questions regarding this matter, she is encouraged to contact Mark R. Buscher (Reg. No. 35,006) at telephone no. (703) 753-8791.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark R. Buscher', written in a cursive style.

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